

REMARKS

Claims 19-31 were previously withdrawn from consideration. Claims 40-43 have been canceled. Claims 32-39 are currently pending, with claim 32 being the sole independent claim. Claims 33-36, 38 and 39 have been amended. Independent claim 32 has been amended to incorporate the subject matter of canceled dependent claims 40-43. The amendments to dependent claims 33-36 correct minor claim wording, and are cosmetic in nature. Dependent claims 38 and 39 have been amended for consistency with independent claim 32. No new matter has been added. Reconsideration of the above-identified application, in view of the following amendment and remarks, is respectfully requested.

Claim Objections

Claims 32-43 have been objected to based on minor claim wording. In view of the amendments to independent claim 32 and dependent claims 33-36, 38 and 39, these objections are deemed to be moot.

Rejections Under 35 U.S.C. §103

Claims 32-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 08-290543 (“*Katsumara*”) in view of U.S. Patent No. 6,631,677 (“*Fuhrmann*”). For the following reasons, reconsideration and withdrawal of these rejections are respectfully requested.

Independent claim 32 has been amended to incorporate the subject matter of dependent claims 40-43. Thus, independent claim 32 now recites, *inter alia*, “at least one printing device, installed inline with the at least one printing unit, and configured to individualize the static or unchanging image by adding at least one dynamic or changing image to the substrate, the at least one printing device being further configured to print at least one dynamic or changing image

receiving a data stream containing data for the at least one dynamic or changing image and being further configured to print at least one of fragrances, varnishes, electrical conductors and semiconductor circuits”. The combination of the cited art fails to teach or suggest this limitation because *Katsumaru* and *Fuhrmann*, individually or in combination fails to teach or suggest the expressly recited subject matter of now amended independent claim 32.

The Examiner at pg. 7 of the Office Action in the rejection of the claims 40-43 has indicated that the printing device of *Katsumaru* is capable of being used to print any desired functionality such as text data, image data, logistics data, fragrances, varnishes, electrical conductors, or semiconductor circuits. Applicants have rewritten the claims to positively recite that the at least one printing device is “further configured to print at least one of fragrances, varnishes, electrical conductors and semiconductor circuits”. As described in more detail below, *Katsumaru* fails to teach or suggest this limitation.

Katsumaru relates to a method for printing “a newspaper having a partially different advertising page by providing an ink jet printing unit and further providing a section for forming a blank space where no printing is made on the web, on a part of a printing plate to be attached to the printing cylinder of a printing device” (see Abstract). *Katsumaru* fails to teach or suggest the expressly recited subject matter of now amended independent claim 32. According to *Katsumaru*, “an ink jet head 9 is activated to print the name of a car dealer controlling the region where the covers and newspaper carrying the advertisement is distributed” (see Constitution, lines 8-11). There is no teaching or suggestion in *Katsumaru* that the ink jet head prints anything other than a color function, i.e., ink. That is, *Katsumaru* fails to teach or suggest “the at least one printing device being further configured to print at least one dynamic or changing image receiving a data stream containing data for the at least one dynamic or changing image and being

further configured to print at least one of fragrances, varnishes, electrical conductors and semiconductor circuits”, as recited in now amended independent claim 32.

As explained at paragraph [0013] of the Examiner-provided English translation of *Katsumaru*, the ink jet unit 9 is formed as a roller type, and is supported pivotally, enabling free rotation. *Katsumaru* (paragraph [0014]; Fig. 3) further explains that “the main part 9a with said cylinder ink jet head 9 and the slit shape ink ject 9c formed in the layer part in parallel with the pivot 9b outside the main part 9a ... comprises the ink jet nozzle 9d provided in the pars basilaris ossis occipitals (sic) of the ink slot 9c, the control electrode 9e laid under the wall surface of the ink jet 9c, the ink tank 9f, the ink pressurizer 9g, etc”. There is no teaching or suggestion whatsoever that the ink jet head 9 of *Katsumaru* is configured to print “at least one of fragrances, varnishes, electrical conductors and semiconductor circuits”, as recited in now amended independent claim 32.

As stated above, the Examiner (at pg. 7) asserts that “the functionality is not part of the positively claimed structure of the printing device and therefore the printing device of Katsumura et al. is capable of being used to print any desired functionality, such as text data, image data, logistics data, fragrances, varnishes, electrical conductors, or semiconductor circuits, to provide different image characteristics to the dynamic or changing image”. Applicants disagree with this assertion. There is nothing whatsoever in *Katsumaru* of the expressly recited subject matter of now amended independent claim 32. *Katsumaru* explicitly discloses that an ink-jet printing unit can be used for nothing other than solely for use in combination with ink, which differs substantially from a printing device that is configured to print at least one of fragrances, varnishes, electrical conductors and semiconductor circuits. In addition, applicants have not claimed the printing of a “functionality” as asserted by the Examiner. Rather, applicants’ now amended independent claim is directed to a printing device that is configured to print at least one

of fragrances, varnishes, electrical conductors and semiconductor circuits, which differs substantially from the teachings of *Katsumaru*.

According to the Examiner, “printing units configured to receive data of the static or unchanging image and to perform in-press imaging of the print drum are well known in the art as exemplified by the press of Fuhrmann et al”. However, there is no teaching or suggestion whatsoever in *Fuhrmann* of the printing device of now-amended independent claim 32.

Fuhrmann relates to a printing machine that is configured “to avoid mechanical inaccuracies that arise due to the transversal movement of the form cylinders or of the printing head or due to the pivotal movement of the imaging system as a whole” (see col. 1, lines 62-66).

As explained in *Fuhrmann*, “light diversion means are used to optionally divert the laser pulses generated by the laser unit to one of the two or more form cylinders” (see col. 2, lines 9-11). *Fuhrmann* (col. 2, lines 11-15) explains that “[t]he light diversion means are, for example, mirrors, prisms or optical waveguides, by means of which the laser pulse can be diverted in accordance with the curvature of the optical waveguides in any desired spatial direction”. Moreover, *Fuhrmann* describes an embodiment in which the “light diversion means ... can include a mirror, a prism, a system of image-forming lenses, a holographic screen or a rotary device for rotating an end of an optical wave guide directable to a surface to be printed”.

There is no teaching or suggestion in *Fuhrmann*, however, that a printing device is configured in the manner expressly recited in now amended independent claim 32. That is, “at least one printing device, installed inline with the at least one printing unit, and configured to individualize the static or unchanging image by adding at least one dynamic or changing image to the substrate, the at least one printing device being further configured to print at least one dynamic or changing image receiving a data stream containing data for the at least one dynamic or changing image and being further configured to print at least one of fragrances, varnishes,

electrical conductors and semiconductor circuits”. *Fuhrmann* thus fails to teach or suggest now amended independent claim 32.

Since *Katsumaru* fails to teach or suggest, “a printing device that is configured to print at least one of fragrances, varnishes, electrical conductors and semiconductor circuits” and *Fuhrmann* fails to provide that which *Katsumaru* lacks, the combination of *Fuhrmann* and *Katsumaru* fails to achieve the device of now amended independent claim 32.

In view of the foregoing, independent claim 32 is patentable over the combination of *Katsumaru* and *Fuhrmann*. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) is therefore in order, and a notice to that effect is respectfully requested.

In view of the patentability of independent claim 32, dependent claims 33-39 are also patentable over the prior art for the reasons set forth above, as well as for the additional recitations contained therein.

Based on the foregoing remarks, this application is in condition for allowance. Early passage of this case to issue is respectfully requested.

Should the Examiner have any comments, questions, suggestions, or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

Respectfully submitted,
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